

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1 and 3-23 are presently pending in this case.

In the outstanding Official Action, Claims 1 and 3-23 were rejected under 35 U.S.C. §112, first paragraph; and Claims 1 and 3-23 were rejected under 35 U.S.C. §103(a) as unpatentable over Tohya et al. (U.S. Patent No. 4,636,703, hereinafter "Tohya") in view of Patino et al. (U.S. Patent Application Publication No. 20050200331, hereinafter "Patino").

With regard to the rejection of Claim 1 under 35 U.S.C. §112, first paragraph, the outstanding Office Action states that the subject matter added to Claims 1 is not explained by the specification, and in particular "It is not clear how the battery terminal provides electric power to the charging unit from the electronic device as said charging unit charges." However, it is respectfully submitted that page 7, lines 34-36 describes that the battery terminal is in electrical contact with the housing chamber side terminal when housed in the battery housing chamber. Further, it is respectfully submitted that one skilled in the art would recognize as being described that a rechargeable battery connected to the electronic device, such as a camera, would be charged by electric power provided by the device when the device is plugged into a power source. Accordingly, Claims 1 and 3-23 are believed to be in compliance with all requirements under 35 U.S.C. §112, first paragraph.

With regard to the rejection of Claim 1 as unpatentable over Tohya in view of Patino, that rejection is respectfully traversed.

Claims 1 and 11 recite a battery device comprising, *inter alia*:

a charging unit fixed inside the case; and  
a battery side terminal disposed on the front surface of  
the case and connected to the battery through the charging unit,  
***the battery side terminal configured to connect to a housing  
chamber side terminal of the electronic device to provide  
electric power to the charging unit from the electronic device***

***as said charging unit charges and to provide electric power from the charging unit to the electronic device through the battery side terminal as the charging unit discharges.***

Tohya describes a charging apparatus including a cell accommodation frame structure 1 and a power supply casing 3 for charging batteries 101-104.<sup>1</sup> The outstanding Office Action cited a charging circuit within power supply casing 3 as “a charging unit” and contact strips 13A, 13B, 14A, 14B, 34A, 34B, 35A, 35B, 36A, and 36B of Tohya as “a battery side terminal.”<sup>2</sup> Further, the outstanding Office Action conceded that Tohya does not teach or suggest the above highlighted features, and cited battery 122 of Pitino being charged by charging unit 110 of Patino as describing this feature.<sup>3</sup>

However, Tohya clearly describes that the device is used to charge cells, *not* discharge them.<sup>4</sup> In this regard, although contact strips 34A, 34B, 35A, and 35B of Tohya may be in contact with the charging circuit within power supply casing 3, the charging circuit within power supply casing 3 ***never charges or discharges***, it simply passes on transformed and rectified power from power supply plug 32 to the contact strips.<sup>5</sup> Thus, it is respectfully submitted that modifying the charging circuit within power supply casing 3 of Tohya as suggested by the proposed combination would be a substantial redesign of the device described in Tohya. Such a modification is contrary to well settled case law which holds that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In this case, Tohya describes a standalone device for recharging batteries 101-104 when plugged into a wall outlet. The device of Tohya does not provide power through power

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<sup>1</sup>See Tohya, abstract and Figures 1A and 4.

<sup>2</sup>See the outstanding Office Action at page 4, lines 11-19.

<sup>3</sup>See the outstanding Office Action at page 5, lines 4-12.

<sup>4</sup>See Tohya, Summary of the Invention.

<sup>5</sup>See Tohya, column 5, lines 1-6.

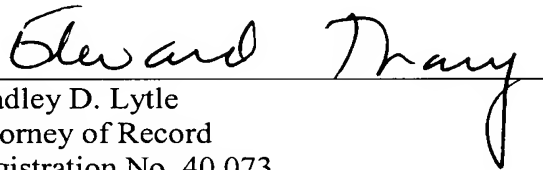
supply plug 32, it only receives it from a wall outlet. Making the suggested modification to include circuitry and structure to allow the device of Tohya to both recharge batteries and to deliver power would require a substantial reconstruction and redesign of the elements shown in Tohya, as well as change in the basic principle under which the Tohya construction was designed to operate. Therefore, there can be no suggestion or motivation to make such a combination. See MPEP §2143.01.

Thus, as there is no suggestion or motivation to make the proposed combination, Claims 1 and 11 (and Claims 3-10 and 12-23 dependent therefrom) are patentable over Tohya in view of Patino.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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